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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,661	03/09/2001	Victor Keith Blanco	MS1-770US	7533
22801	7590	12/22/2003	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			NGUYEN, KIM T	
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 12/22/2003				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/802,661	BLANCO, VICTOR KEITH
	Examiner	Art Unit
	Kim Nguyen	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-44 is/are pending in the application.
 - 4a) Of the above claim(s) 21-44 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3, 5 & 7</u> . | 6) <input type="checkbox"/> Other: _____ . |

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DETAILED ACTION

Applicant's election in the Response to Restriction Requirement filed on September 26, 2003 (paper no. 6) is acknowledged. Currently, applicant elects Group I, claims 1-20. By the election, claims 1-20 are examined, and claims 1-44 are pending.

Information Disclosure Statement

1. The information disclosure statement filed March 24, 2003 (paper No. 3) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

2. Claims 1 and 9 are objected to because of the following informalities:
- a) In claim 1, line 4, the claimed limitation "memory" should be corrected to "the memory".
 - b) In claim 9, line 2, the abbreviation "WMA" should be expressed in a long format before the abbreviation could be used.

Appropriate correction is required.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1, 3, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al (US. Patent No. 6,464,585).

a. As per claim 1 and 3, Miyamoto discloses a game console comprising a memory, a processor coupled to the memory (col. 11, lines 1-19), and a console application configured to create a soundtrack (col. 12, lines 57-67; col. 13, lines 1-4; col. 15, lines 31-39 and 45-52).

b. As per claim 13, Miyamoto discloses displaying a listing of all available soundtracks (Fig. 14, col. 19, lines 26-42).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 4-12, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Miyamoto et al (US. Patent No. 6,464,585).

a. As per claim 2 and 4-10, Miyamoto discloses different disk drives (col. 14, lines 4-20).

Further, implementing a hard disk drive to a game console using a CD, DVD, game disc as a storage medium, retrieving audio data from an online source and storing soundtrack in a memory as a WMA file, and retrieving audio tracks from audio source would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a well known hard disk drive to the game console of Miyamoto in order to facilitate storing and retrieving data to the game console.

b. As per claim 11-12, since Miyamoto discloses outputting a soundtrack according to the player's selection and the progress of the game (col. 1, lines 8-10; and col. 19, lines 34-41), Miyamoto obviously discloses associating the soundtrack with the game. Further, outputting a soundtrack associated with a specific user who shares a device with a plurality of users would have been well known.

c. As per claim 14 and 18, refer to discussion in claim 1 above. Miyamoto discloses capability of creating a soundtrack (col. 15, lines 31-39). Further, Miyamoto discloses providing an interface to facilitate playback (Fig. 14; col. 19, lines 26-42). Miyamoto does not disclose

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presenting an interface for creating a soundtrack. However, Miyamoto discloses allowing the player to input sound (col. 18, lines 41-47), and the capability of organizing the sound in order (col. 15, lines 48-52 and 31-39). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an interface to facilitate inputting the sound and organizing the sound data to the player.

- d. As per claim 15-17, refer to discussion in claim 10-12 above.
- e. As per claim 19-20, refer to discussion in claim 13 above.

Cited References

- 7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - i. *Sherman et al* (US. 6,535,269) discloses using hard drive, CD, or DVD, etc. as a storage device (col. 2, lines 9-36).
 - ii. *Sano* (US. 6,309,301) and *Kondo et al* (US, 6,280,329) disclose using soundtracks using in a video game.
- 8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:00AM to 5:00PM ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg, can be reached on (703) 308-1327. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

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Date: December 12, 2003



KIM NGUYEN
PRIMARY EXAMINER